

### **REMARKS**

Claims 2-12 are pending in this application after this amendment. Claim 1 has been canceled without prejudice or disclaimer to the subject matter included therein. Claims 2, 7 and 12 are independent. In light of the amendments and remarks made herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

By this amendment, Applicant has amended the claims to more appropriately recite the claimed invention. It is respectfully submitted that these amendments are being made without conceding the propriety of the Examiner's rejections, but merely to timely advance prosecution of the present application.

Applicant wishes to thank the Examiner for indicating that claims 2 and 4-7 include allowable subject matter.

In the outstanding Official Action, the Examiner rejected claims 1, 3, and 8-12 under 35 U.S.C. §103(a) as being unpatentable over Werner (DE10114950) in view of Moon (USP 6,195,686). The Examiner further objected to claim 12 based on minor informalities. Applicant respectfully traverses these rejections.

### **Claim Objections**

The Examiner objected to claim 12 based on minor informalities. By this amendment, Applicant has amended claim 12 to correct the minor informality. Based on this amendment, it is respectfully requested that the outstanding objection be withdrawn.

### **Claim Rejections – 35 U.S.C. §103**

By this amendment, Applicant has rewritten claims 2 and 7 in independent form including all of the elements recited in claim 1. As the Examiner indicated that claims 2 and 7 include allowable subject matter, Applicant submits that these claims, together with claims dependent thereon, are in proper form for allowance.

By this amendment, Applicant has rewritten claim 12 in independent form including all of the elements recited in claim 1.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

In support of the Examiner's rejection of claim 12, the Examiner asserts that Werner discloses the input means and the communication means as claimed. The Examiner admits that Werner fails to teach or suggest the other elements recited in claim 1. The Examiner relies on the teachings of Moon to cure the deficiencies of the teachings of Werner. The Examiner further relies on the teachings of Werner to teach the short message data is created at the communication terminal, citing to the Abstract and the input to the fax machine. The Examiner asserts that one skilled in the art would be motivated to modify the teachings of Werner with the teachings of Moon in order to provide the capability of interfacing with a plurality of mail servers utilized by different mail service providers, citing to col. 3, lines 8-11 of Moon. Applicant respectfully disagrees with the Examiner's characterization of these references.

Werner discloses a fax machine with short message service functionality having a protocol stack that processes short messages received/transmitted in SMS format to output into and transmit from the fax machine.

In a separate field of endeavor, the disclosure of Moon is directed to a messaging application having a plurality of interfacing capabilities. The system provides for a user communications device having a messaging application.

In asserting his rejection of the claim, the Examiner seeks to modify the facsimile machine of Werner with the processing capabilities of the user communication terminal of Moon. Applicant submits that one skilled in the art would not be motivated to modify the facsimile machine of Werner with the capabilities of the user communication device of Moon.

As one skilled in the art would not be motivated to modify the teachings of Werner, Applicant submits that the Examiner has failed to establish *prima facie* obviousness. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 3 and 8-11 are allowable for the reasons set forth above with regard to claim 12 at least based on their dependency on claim 12.

### **Conclusion**

In view of the above amendment and remarks, Applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet Reg. No. 52,327 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/650,915  
Amendment dated January 22, 2009  
Reply to Office Action of July 22, 2008

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: January 22, 2009

Respectfully submitted

By 

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